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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,295	10/28/2003	Lawrence Morrisroe	085804-010801	5110

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EXAMINER	
RETTA, YEHDEGA	
ART UNIT	**PAPER NUMBER**
3622	

NOTIFICATION DATE	DELIVERY MODE
11/02/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/696,295	MORRISROE ET AL.	
	Examiner	Art Unit	
	Yehdega Retta	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 August 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28 and 31-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28 and 31-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This office action is in response to the amendment filed August 20, 2007. Claims 1-28 and 31-33 are still pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 7-10 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by of Solbright White Paper; "The Inside Edge on Rich Media Partnership Series"; March 2001, (herein after Solbright).

Regarding claim 1, Solbright teach integrating an input file (Flash ad) and conduit file (tracking code) and creating an integrated file; serving the integrated ad file from a computer to provide the ad (see pp 17-19);

Regarding claim 4, Solbright teaches the use of Macromedia Flash; wherein the ad is Flash ad and the files are "swf" files (see pp 17 see also the sites for the "Macromedia's Rich Media Tracking Kit" cited in White Paper, page 17)).

Regarding claims 7-10, Solbright teaches the ad including one or more actions for linking to one or more web pages where in the integrated ad file includes html code loading a JavaScript file, for loading the integrated ad file; tracking the ad using the code in the conduit file and tracking identifier; the html code including a variable and the conduit file includes code that

determined where the ad opens in a parent window or new window based on the variable (see pp 18-20, see also www.macromedia.com/solutions/richmedia/tracking/advertising_guide/).

Regarding claim 33, Solbright teaches the ad is provided to a user computer via the Internet and combining of the files is in response to receiving a request for a Web page and serving the integrated ad file as par of the web page (see pp 17-20).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2, 3, 5, 6, 11-28, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Solbright White Paper; "The Inside Edge on Rich Media Partnership Series"; March 2001, (herein after Solbright) in view of Official Notice.

Regarding claims 2, 3, 13, 14, 22, 23 and 28, Solbright does not explicitly teach receiving a modified ad file or conduit file. Solbright teaches designers creating their ads and developers or programmers adding the tracking string after the ads are created. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to known that the designer or programmers of Solbright would accept a new or modified information or content from the source and insert the same or different tracking information according to the goals of the campaign or the preference of the tracking server.

Regarding claims 5 and 6, Solbright does not explicitly teaches the input file includes an empty movie object and inserting the conduit file in the empty movie object; wherein the empty movie clip is given a predefined name and searching for the predefined name. However official notice is taken that well known in the art of movie clip create empty movie clip and to assign a predetermined name. It is well known to create an empty movie clip using Macromedia Flash, one that contains no data or graphic content, so that external files (JPGS or SWF) can be loaded into it. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the empty clip as a placeholder for external file such as the tracking data, if the ad is a movie clip.

Regarding claims 11, 12, 15-21, 24-27, Solbright teaches identifying a first file (flash ad); identifying a second file (tracking information); wherein the first file specifies ad content code and the second file contains ad-tracking code; creating an ad file including computer code for providing the ad; wherein the first file specifies ad content code and the second file contains an ad-tracking code; html code loading ad file (third file); third file including one or more buttons; creating the (see pp 17-20). Solbright does not explicitly teach identifying a placeholder (an empty movie clip) in the first file and electronically inserting the second file in the placeholder to create an ad file. However official notice is taken that is old and well known in the art of programming to create empty movie clip using Macromedia Flash. Macromedia Flash is used to create an empty movie clip, one that contains no data or graphic content, so that external files (JPGS or SWF) can be loaded into it. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to create an empty movie clip, in rich media, as a

placeholder for external files such as the tracking data to be inserted in it, if the ad is a movie clip.

Regarding claims 31 and 32, Solbright teaches the integrated ad file includes one or more exit code referring to one or more URL variables; wherein the integrated ad file is designed to be loaded and wherein the ad is provided (see pp 17-20).

Response to Arguments

Applicant's arguments filed August 20, 2007 have been fully considered but they are not persuasive.

Applicant argues that as is described in the cited portion, Solbright requires that someone, such as a programmer, modify a Flash ad file to incorporate action code needed to track an ad. See, for example, the process described at page 18 of Solbright, which requires that someone manually add a "getURL(clickTag) action" to a Flash ad file. The Examiner concedes that Solbright requires that a Flash ad be manually edited. More particularly, in the stated grounds for rejecting Claims 2, 3, 13, 14, 22, 23 and 28 found at page 3, the Examiner states that Solbright describes "designers creating their ads and developers or programmers adding the tracking string after the ads are created." In order to track an ad, for each Flash ad file, Solbright's approach requires that a programmer edit the file to include the getURL action code to the Flash ad file. Thus the ad file is changed. The Solbright ad file is not combined with a separate conduit file as claimed. it remains just an ad file. If a change needs to be made to the action code, or a new Flash ad file is created, additional programming effort is needed to edit Solbright's Flash ad file. In stark contrast, the invention of the present claims creates an integrated ad file by combining an ad input file and a conduit file. A modified integrated ad file can be created by combining a

modified ad input file and/or a modified conduit file. The other element, an HTML wrapper, described in the cited portion of Solbright cannot be said to correspond to the claimed ad input file, the claimed conduit file, or the claimed integrated ad file. According to Solbright, the HTML wrapper is accessed only after the Flash ad is served to the user computer, the ad is displayed in a browser window of the user's computer, and the user provides button input in connection with the displayed ad. An HTML wrapper that is only accessed after a Flash ad is served and displayed to a user computer, and after the user interacts with the displayed ad, cannot be said to correspond to the claimed integrated ad file served from a computer to provide an ad, and further cannot be said to correspond to the ad input file and conduit file combined to create the integrated ad file that is then served.

Solbright teaches as follows:

> One of the biggest barriers to the adoption of rich media technologies like Macromedia Flash has been confusion about how to incorporate performance tracking within an uneditable compiled file. For other media types, the publisher usually inserts a unique tracking string within the source code for the ad to count the click before displaying the destination web page for the advertiser. At the time that the ad is served on the web page, unique IDs identify on which page the ad appeared, the time, and the location. This enables the publisher to provide the specific performance metrics for each placement of the ad on their site. Until now, advertisers and web publishers followed laborious and costly processes for each ad placement to get the correct tracking string inserted:
>
> 1. The media buyer contacted the site's production staff to get the appropriate tracking string.
>
> 2. The media buyer transferred the tracking string information to the Macromedia Flash developer.
>
> 3. The developer created a unique copy of the Macromedia Flash source file (FLA) and hard-coded the tracking string into the creative.

4. The developer delivered the appropriate version of the Macromedia Flash ad (SWF file) to the media buyer.

5. The media buyer sent the creative to the publisher.

6. If the right version of the ad was sent to the publisher and the tracking string was inserted correctly, the ad would go live with the performance metrics being captured by the ad server. Otherwise, incorrect metrics, if any, would be recorded, skewing the results of the campaign. If the publisher realized the mistake, the process would repeat, beginning at Step 2, until the correct file was sent back to the publisher.

To help ease the burden of this process, the MFAA advises developers to create an editable HTML wrapper for the ad that uses the <object> and <EMBED> tags to pass through the appropriate parameter for the tracking string to the getURt, action command within the compiled SWF file.

MFAA Recommend Process for Inserting the Tracking String

1. Create a Macromedia Flash ad with at least one button element

2. For the button that will be used to track the clickthrough data, assign a simple getURL(clickTAG) action.

3. Create an alternate GIF version of the ad.

4.Create an HTML wrapper file that uses the <OBJECT> and <EMBED> tags to pass the appropriate parameters for the tracking string to the ad. Each publisher will need to modify this file to insert their own, unique tracking code. This file should also have the appropriate sniffer code to detect the presence of the Macromedia Flash Player, and to display the alternate GIF ad if necessary.

According to applicant disclosure, the operations performed by the portal 100 (e.g., an administrator 108) in creating the integrated ad file 204 to be served via the ad server 102, *the portal 100 uses a merge tool 502 to combine the contents of an ad input file 504 provided by the Advertiser 110 with the contents of a conduit file 506 created by the portal 100. In general, the ad input file 504 contains the content of the ad, as provided by the advertiser,* ***and the conduit file 506 contains code for tracking the ad.*** According to applicant the merge tool 502 is an

executable program that combines the content of the ad file 504 with the contents of the conduit file 506 to create an integrated ad file 204 ("ad_done.swf"). The merge tool 502 may take any number of forms, may have any number of different user interfaces, and may be written in any number of languages, including C++, Java, Perl, and the like. As such, the merge tool make take the form of a web-based application accessible via an Internet Web page.

According to applicant's invention the advertiser creates the content of the ad (504) and the portal uses 502 to ad conduit file (tracking code) to the ad. Therefore, the tracking code are created and added to the ad file at the server, same as the prior art; the same as creating an HTML wrapper file that uses the <OBJECT> and <EMBED> tags to pass the appropriate parameters for the tracking string to the ad and then each publisher will need to modify this file (wrapper file) to insert their own, unique tracking code (same as applicant merge file to add the tracking code (conduit file)).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Yehdega Retta
Primary Examiner
Art Unit 3622

YR